

REMARKS/ARGUMENTS

Claims 1-7 are pending in the application. Applicant, by this paper, withdraws claims 8-12 in light of the Restriction requirement. Applicant respectfully requests reconsideration and allowance of all pending claims.

Discussion of Restriction of Claims

The Examiner restricts the claims into two groups consisting of claims 1-7 and claims 8-12, directed to a process and apparatus for its practice. The Examiner applies a constructive election of claims 1-7, because the claims have already received an action on the merits. As such, Applicant cancels claims 8-12 without prejudice.

Discussion of Provisional Double Patenting Rejection

Claims 1-7 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-7 of co-pending U.S. Patent Application No. 10/769,420 (the '420 application) in view of U.S. Patent Application Publication No. 2004/0242209 to Kruis et al (hereinafter Kruis).

Applicant understands that the obviousness-type double patenting rejection is provisional, in light of the pendency of both applications. Applicant notes that the claims of either the instant application or the '420 application may be amended during the course of prosecution, thereby overcoming the basis for the obviousness-type double patenting rejection. Therefore, at this time, Applicant does not submit a Terminal disclaimer nor claim amendments addressing the obviousness-type double patenting rejection, but reserves the right to do so should the '420 application mature into a patent.

Discussion of Rejections Under 35 U.S.C. §103

Claims 1-7 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0115453 to Poulin et al. (hereinafter Poulin) in view of Kruis.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

Applicant contends that a *prima facie* case for obviousness has not been established and respectfully traverses the rejections. In particular, Applicant contends that the references, either alone or in combination, fail to teach or suggest all claimed features. Additionally, there is no motivation to modify or combine the references in a manner that would result in Applicant's claimed invention.

Claim 1 recites "[a] method for authenticating an application run on a mobile station." The method includes: "attempting to run Location Based Service (LBS) application on the mobile station" and "requesting authentication of the LBS application." The method further includes: "communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the LBS application."

Poulin In View of Kruis Fails to Teach or Suggest All Claimed Features

Claim 1 features "requesting authentication of the LBS application." At least this feature is not taught nor suggested by either Poulin or Kruis. The Examiner contends that Poulin teaches or suggests this claimed feature at paragraphs 25, and 28-30. *See, Office Action*, dated October 19, 2006, at page 4. In particular, the Examiner identifies the portion of Poulin that describes accessing a user profile within a subscriber's wireless device, and states that "Verification of a *subscriber* is needed to access the proper user profile." *Id.*, at 5 (*emphasis added*).

The Examiner cites to Applicant's background as supporting the Examiner's interpretation of Poulin as teaching or suggesting the claimed feature. The Examiner states: "As noted in applicant's specification, authorization involves verifying of subscribers identity and billing (see paragraph 1004 of the specification)." *Id.* However, the Examiner fails to note that this portion of Applicant's Background portion describes one aspect of *authorizing an application*, not accessing a user profile of a *subscriber*, as described in Poulin. Indeed, Applicant's Background section further describes a desire for "some security to be put in place that would ensure that the mobile station is not triggered by an external device that is not authorized to do so." *Applicant's Specification*, at paragraph [1005]. Thus, Applicant's own Specification clearly distinguishes the claimed invention over merely verifying a subscriber identity and billing.

Poulin fails to distinguish accessing a subscriber user profile over authenticating an *application* run on the mobile station. Indeed, the feature of Poulin fails to teach or suggest

that accessing a user profile can be performed on an *application* basis. Poulin fails to teach or suggest that there are some *applications* run on the mobile device that can be authenticated, while other *applications* run on the *same* mobile station may not be authenticated. Poulin fails to even recognize the distinction.

The Examiner does not contend that Kruis teaches or suggests this claimed feature. Thus, the combination of Poulin with Kruis also fails to teach or suggest a claimed feature that is absent from each reference individually.

Similarly, with respect to the claimed feature of "communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the LBS application," the Examiner cites to Poulin paragraphs 25, 28-30, 36, and 62-62. The Examiner alleges the cited portions of Poulin teach or suggest the claimed feature. In particular, the Examiner states that the "location based service center handles requests from all mobile devices." *Office Action*, at 5. The cited portion of Poulin fails to teach or suggest how a Location Based Service Center (LBSC) can authenticate an application; instead, Poulin merely describes the LBSC as receiving and managing the profile information for subscribers of the communication service. *Poulin*, at paragraph [0037]. Poulin fails to teach or suggest that the LBSC has any ability to distinguish one *application* from another run on the same mobile station. Poulin fails to teach authenticating the *application*.

The Examiner does not contend that Kruis teaches or suggests this additional claimed feature. Thus, the combination of Poulin with Kruis also fails to teach or suggest a claimed feature that is absent from each reference individually.

Applicant respectfully requests reconsideration and allowance of claim 1 at least for the reason that Poulin and Kruis, whether alone or in combination, fail to teach or suggest every claimed feature.

There is No Motivation to Combine Poulin With Kruis

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The Examiner contends that "it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify POULIN to include the method to

limit information needed to run an application if authentication failed, as taught by KRUIS, since KRUIS states that such a modification would allow real time management of services." *Office Action*, at pages 5-6 (*citing* Poulin paragraphs 11, 12, 15, and 16).

As noted in prior Applicant response, Kruis relates to self-provisioning in a mobile communication device. As explained in Kruis, the provisioning process relates to initial activation of a newly purchased mobile device or adding, removing, or modifying mobile device related services offered by a network operator. *Kruis*, at Col. 1, paragraphs [0002]-[0003] and paragraph [0007]. Poulin is directed to location based wireless communication services. Neither Poulin nor Kruis are directed to authenticating LBS applications.

The paragraphs from Kruis cited to by the Examiner as providing the motivation to modify Poulin all relate to self-provisioning of a mobile device. The Examiner fails to provide any analysis or reasoning that relates self-provisioning of a mobile device to location based services. Moreover, the references lack any teaching or suggestion that relate self-provisioning to running LBS application on a mobile station.

The Examiner provides the generalized motivation of "allow[ing] real time management of services." *Office Action*, at 5-6. However, there is nothing specific in the motivation that would lead one to the specific modification of a location based services method or system, as argued by the Examiner. Poulin fails to describe self-provisioning of the location based services or any provisioning of services.

There is nothing about the generalized motivation to allow real time management that relates to the specific modification proposed by the Examiner. That is, there is nothing about real time management of self provisioning that relates to modifying a location based application running on a mobile station. Certainly, there is nothing in the generalized motivation that relates to, teaches, or suggests modifying a location based services application authentication process.

Therefore, although the Examiner provides a generalized motivation to modify the references, there is nothing in the generalized motivation that would lead one of ordinary skill in the art to make the specific modification argued by the Examiner in the rejection. Moreover, there is nothing in the references or otherwise identified by the Examiner that would lead one of ordinary skill in the art to look to a reference describing self-provisioning of a mobile device in combination with running location based services.

Applicant respectfully requests reconsideration and allowance of claim 1, at least for the reason that there is no motivation to combine Poulin with Kruis in the manner suggested by the Examiner.

Discussion of Dependent Claims

Claims 2-7 depend, either directly or indirectly, from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 2-7.

CONCLUSION

Applicant believes that all claims pending in the application are allowable. Applicant therefore respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned.

Respectfully submitted,

Dated: April 18, 2007

By: /Linda G. Gunderson/
Linda G. Gunderson
Attorney for Applicant
Registration No. 46,341

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121-2779
Telephone: (858) 651-7351
Facsimile: (858) 658-2502
61026290 v1